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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/925,372 09/08/97 DORN H BAYER9265.1K

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HM12/0403

EXAMINER

ROBINSON, A

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

04/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/925,372

Applicant(s)

Dorn et al.

Examiner

Allen Robinson

Group Art Unit

1617



☒ Responsive to communication(s) filed on Feb. 22, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 17, 18, and 21-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 26 is/are allowed.

☒ Claim(s) 17, 18, and 21-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 33

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Claims 17, 18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kristiansen et al.(A), Shiokawa et al.(B), Elbert et al. (AT) and Derwent Abstract of JP 03,279,389 (AR'') and European Patent 0,285,985 (AJ*'), all of record and for reasons of record as set forth in paper number 29, pages 2 and 3. Applicants's arguments and the data sheets presented have been carefully considered; however, they are not deemed persuasive.

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The prior art teaches that the claim designated pyridinylmethyl & thiazolylmethyl-imidazolidinium compounds, analogues, and isomers thereof are known insecticides, effective against insects of the type claimed and may be applied in a non-systemic control method such as dermal application. For example see the Kristiansen et al. reference, col. 4, lines 10-23 and col. 15(cat fleas) and the European Patent page 7, wherein fleas may be controlled by dermal application of the active ingredient. Therefore, no patentable distinction can be seen between the claims of record and the state of the art as taught by the prior art. Claims 17, 18 and 21-25 will be favorably considered if: (1) The data presented is put into a declaration; and (2) the claims are limited to **R is pyridylmethyl, optionally substituted by halogen or C₁₋₄ alkyl (claim 17)**.

Claim 26 is allowed.

References and AR'' are cited to show the state of the art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Robinson whose telephone number is (703) 308-4524.

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AJR

March 30, 2000

Allen J. Robinson
ALLEN J. ROBINSON
PRIMARY EXAMINER
CR011P1200